

REMARKS

Claims 1-30 are pending in the application.

Claim Rejections – 35 USC § 102(e)

The Examiner indicated that Claims 1-26 are rejected under 35 USC Section 102(e) as being anticipated by Darbee et al., U.S. Patent Number 6,130,726 (Darbee). The Applicant respectfully disagrees.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, “anticipation requires the presence in a single prior art reference disclosure of **each and every element** of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1982) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1984)) (emphasis added).

Regarding Claims 1, 8 and 14, the Claims include the limitation of “determines whether event related program guide data is available in the second information handling system, and, in the even the event related program guide data is not available, the second information handling system sends a request for the program guide data to the first information handling system.” The Examiner, in the *Examiner's Response*, asserts that “the remote control 10, receives information based on the identity of a user, where based on a users identification, receives/filters/parses out data according to users preferences/viewing habits” and further asserts that “the remote control 10 is constantly monitoring the user and once the user is identified the remote is monitoring the commands entered from the user and also retrieving/filtering/parsing out the appropriate data to display to the respective user.” This is not the present invention.

The present claimed invention determines “whether data is available in the second information handling system, and if it is not, sends a request to the first information handling system.” On the contrary, the Darbee remote control 10 receives all the information and filters the information. The Darbee reference does not mention determining whether the data is in the remote control, and further does not mention

requesting the data. The Examiner has not shown where such a disclosure, teaching or suggestion for determining is contained in the Darbee reference. Therefore, it is respectfully submitted that a *prima facie* case of anticipation had not been established, and withdrawal of the rejection is respectfully requested.

Claim Rejections – 35 U.S.C. §103(a)

The Examiner rejected Claims 27-30 under 35 U.S.C. §103(a) as being unpatentable over Darbee et al., U.S. Patent No. 6,130,726. The Applicant respectfully disagrees.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). With respect to Claim 27, guide data is displayed by both the first information handling system and the second information handling system, which is not taught or suggested by the submitted reference. The Examiner correctly asserts that “However, Darbee remains silent on the [sic] being capable of displaying program content and displaying program guide data on the television receiver or set-box (first display).”

The Examiner then asserts various portions of the Darbee reference for support of displaying guide data on a first device. For example, the Examiner first asserts Col. 1, Lines 29-39, which states the following.

Electronic Program Guides (EPGs) or Interactive Program Guides (IPGs) are applications which normally run on a screen of a television set or on a set-top box, with the program guide information appearing on the screen of the television. The problem with this approach is that the guide data must either replace or overlay the program that the user is watching, thus interfering with normal program viewing. This is especially a problem when a group of people is watching the television set and only one of them (usually the one with the remote control) wants to access the program guide. *Darbee, Col. 1, Lines 29-39.*

This section teaches the undesirability of showing guide data on a first device. Indeed, Darbee even gives an extensive listing of patents, and then asserts the following.

However, in all instances, the program data is limited to information concerning a particular song or video title that is being or may be broadcast, and there is no suggestion that the program

data could or should include graphic program scheduling or advertising data. A typical program message includes, for example, information concerning the composer, track title, the artist and the album associated with the track title. *Darbee, Col 2, Lines 17-22.*

Thus, *Darbee* suggests that in "all instances", the data is only displayed on the viewing device, because "those skilled in the art failed to fully appreciate the usefulness of a remote control device." *Darbee, Col 2, Lines 27-29.* To address these problems, *Darbee* provides data on the remote control unit 10, and NOT the viewing device, i.e. television, and teaches away from displaying data on the viewing device, "without causing an interruption in content that is being depicted on an associated television monitor." *Darbee, Col. 2, Lines 48-49.*

However, the present claimed invention claims displaying the data on BOTH the first information handling system and the second information handling system. "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." *M.P.E.P. 2131.02, citing W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).* In the present case, the Examiner's proposed modification to the *Darbee* reference would change the reference in such as way as to be contradictory to the problem it is trying to solve, as stated by the reference itself. The submitted reference, including the submitted portions, fail to teach or suggest the display of guide data on both the first information handling system and the second information handling system.


Therefore, it is respectfully submitted that a *prima facie* showing of obviousness has not been established, and withdrawal of the rejection is respectfully requested.

CONCLUSION

In light of the forgoing, reconsideration and allowance of the claims is earnestly solicited.

Respectfully submitted,
Gateway, Inc.

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By: 
William J. Breen, III
Reg. No. 45,313

William J. Breen, III
SUITER & ASSOCIATES PC
14301 FNB Parkway, Suite 220
Omaha, NE 68154
(402) 496-0300 telephone
(402) 496-0333 facsimile